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EXAMINER

NGUYEN, TU X

| ART UNIT | PAPER NUMBER |
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2618

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,979

Applicant(s)

TERNULLO ET AL.

Examiner

Tu X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-14,17,18,21,22 and 24-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-14,17,21,22 and 24-47 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's arguments with respect to claims 1, 3-4, 7-14, 17-18, 21-22, 24-47 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41 and 44-45, are rejected under 35 U.S.C. 103(a) as being obvious over Mankoff (US Patent 6,385,591) in view of Sharma (US Patent 6,766,163).

Regarding claim 41, Mankoff discloses a system for providing contextually-relevant information to a user comprising:

means for receiving by the transmitter electronic raw data about a service (see col.3 lines 50-65);

means for determining by the transmitter said contextually-relevant information about said service from said electronic raw data (see col.3 lines 50-65);

means for formatting by the transmitter said contextually-relevant information into a standard machine-readable format (see col.2 line 51 through col.3 line 49);

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means for transmitting by the transmitter said contextually-relevant information (see col.2 line 51 through col.3 line 49);

means for receiving by a client said contextually-relevant information; means for providing to the user by the client said contextually-relevant information (see col.2 line 51 through col.3 line 49).

Mankoff fails to disclose information formatted by the transmitter.

In the related art, Sharma discloses information formatted by the transmitter (see col.4 lines 55-66). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mankoff with the above teaching of Sharma in order to provide a XML standard grammar that is well understood by other devices.

Regarding claim 44, Mankoff discloses a system for providing contextually-relevant information to a user comprising:

a transmitter including: a network interface capable of receiving electronic raw data about a service; a data capable of determining the contextually-relevant information about the service from the electronic raw data, said data formatter capable of formatting the contextually-relevant information into a standard machine-readable format; and an optical transmitter capable of transmitting the contextually-relevant information; and a client including an input/output module capable of receiving the contextually-relevant information; and a processing module for providing to the user by said client the formatted contextually-relevant information (see col.3 lines 1-49).

Mankoff fails to disclose information formatted by the transmitter.

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In the related art, Sharma discloses information formatted by the transmitter (see col.4 lines 55-66). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mankoff with the above teaching of Sharma in order to provide a XML standard grammar that is well understood by other devices.

Regarding claim 45, the modified Mankoff discloses processing module is capable of determining when the formatted contextually-relevant information is preferred by the user (see Mankoff, col.3 lines 5-16).

Claims 1, 3-4, 8-14, 17, 21-22, 24-43 and 46-47, are rejected under 35 U.S.C. 103(a) as being anticipated over Mankoff (US Patent 6,385,591) in view of Sharma (US Patent 6,766,163) and further in view of Treyz et al. (US Patent 6,587,835).

Regarding claims 1, 29 and 37, Mankoff disclose a transmitter for receiving information from a service provider about a service and for conveying the information to a handheld device (col.2 lines 4-5, wireless connection is inherent includes transmitter and receiver), said transmitter comprising:

means for defining a context (see fig.3) in said transmitter; means for receiving the information at said transmitter;

means for produce a transmitted signal compatible with the handheld device and relevant to said context (see col.3 lines 10-49); and

said information displayed to a user of the handheld device (see col.4 lines 5-17, col.5 line 40-41);

wherein said conveying means transmits a diffuse infrared signal (see col.3 line 25-36);

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wherein said machine-readable form is an XML element (see col.2 line 62 through col.3 line 49, hyperlink is inherent programmable in an XML element), and

wherein said XML element is encapsulated in an integrity element (see col.5 line 25-45).

Mankoff fails to disclose means for conveying said transmitted signal from said transmitter to the handheld device located within said context.

In the same field of advertisement provider, Treyz et al. disclose means for conveying said transmitted signal from said transmitter to the handheld device located within said context (see col.55 lines 30-34) if user has previously expressed an interest in the service. Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mankoff with the above teaching of Treyz et al. in order to provide the receiver receiving coupons when it is detected in range of retail store.

Mankoff fails to disclose information formatted by the transmitter.

In the related art, Sharma discloses information formatted by the transmitter (see col.4 lines 55-66). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mankoff with the above teaching of Sharma in order to provide a XML standard grammar that is well understood by other devices.

Regarding claim 3, the modified Mankoff fails to disclose said diffuse infrared signal has a wavelength substantially in the range of 850 nanometers to 1250 nanometers. The Examiner takes an Official notice is taken that the concept the frequency range 850 nanometers to 1250 nanometers is well known in the art. It would have been obvious the infrared signal is made at above range of 2 MHZ and below .8 MHZ range.

Regarding claims 4, 11, 24, 28 and 31-32, the modified Mankoff discloses said diffuse infrared signal is generated by modulating an electric light (see Mankoff, col.5 lines 19-20, "infrared" is inherent modulating an electric light).

Regarding claim 9, Mankoff discloses a handheld device operating in a context associated, said handheld device comprising:

means for receiving the signal (see col.2 line59 through col.3 line 49), said received signal including information from a service provider offering a service (see col.2 lines 1-5), and means for extracting said information when a user of said handheld device has expressed an interest in such a service; wherein said information includes a first XML element; and wherein said information is encapsulated in an integrity element (see col.5 lines 25-45).

Mankoff fails to disclose means for conveying said transmitted signal from said transmitter to the handheld device located within said context.

In the same field of advertisement provider, Treyz et al. disclose means for conveying said transmitted signal from said transmitter to the handheld device located within said context (see col.55 lines 30-34) if user has previously expressed an interest in the service. Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mankoff with the above teaching of Treyz et al. in order to provide the receiver receiving coupons when it is detected in range of retail store.

Mankoff fails to disclose information formatted by the transmitter.

In the related art, Sharma discloses information formatted by the transmitter (see col.4 lines 55-66): Therefore, It would have been obvious to one of ordinary skill in the art at the time

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the invention was made to modify the system of Mankoff with the above teaching of Sharma in order to provide a XML standard grammar that is well understood by other devices.

Regarding claims 8, 10, 22, 33, and 38, the modified Mankoff discloses said means for extracting includes a plug-in, said plug-in executes when said interest is expressed (see Mankoff, col.3 lines 10-15).

Regarding claim 12, the modified Mankoff discloses displaying at least a portion of said information to the user (see Mankoff, col.4 lines 5-35).

Regarding claim 13, the modified Mankoff discloses means for accepting an input from the user, said input provided in response to said at least a portion of said information (see Mankoff, col.3 lines 16-19).

Regarding claim 14, the modified Mankoff discloses comprising a means for sending a reply in response to said input to the transmitter (see Mankoff, col.2 lines 3-5).

Regarding claim 17, the modified Mankoff discloses said integrity element includes a second XML element (see Mankoff, col.5 lines 31-32).

Regarding claim 21, the modified Mankoff discloses the step of utilizing a behavior of the user to establish the preference (see col.5 lines 40-45).

Regarding claim 25, Mankoff discloses a method for establishing a context of a user with a transmitter, said method comprising the steps of: receiving information at the transmitter, the transmitter being communicatively associated with a handheld device, the information being of interest to the user of the handheld device if located within the coverage area; encapsulating the first XML element in a second XML element, the second XML element being an integrity element; converting the first XML element and the integrity element into a signal; and emitting

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the signal to the handheld device located within the coverage area, the information displayed to the user of the handheld device if the user has established a preference at a time prior to receiving the signal (see col.2 line 51 through col.4 line 3 and col.5 lines 6-45).

Mankoff fails to disclose means for conveying said transmitted signal from said transmitter to the handheld device located within said context.

In the same field of advertisement provider, Treyz et al. disclose means for conveying said transmitted signal from said transmitter to the handheld device located within said context (see col.55 lines 30-34) if user has previously expressed an interest in the service. Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mankoff with the above teaching of Treyz et al. in order to provide the receiver receiving coupons when it is detected in range of retail store.

Mankoff fails to disclose information formatted by the transmitter.

In the related art, Sharma discloses information formatted by the transmitter (see col.4 lines 55-66). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mankoff with the above teaching of Sharma in order to provide a XML standard grammar that is well understood by other devices.

Regarding claims 26-27 and 36, the modified Mankoff discloses emitting a time element in conjunction with the first XML element and the integrity element; and establishing a temporal context for the user using the time element (see col.4 lines 17-35 and col.5 lines 25-45).

Regarding claims 34 and 37, Mankoff discloses a method of utilizing executable code in a transmitter to establish a context of a user having a handheld device and operating with the transmitter, the method comprising the steps of:

receiving through the executable code in the transmitter, information about a service at the transmitter; and emitting the signal, from the transmitter, the information displayed to the user of the handheld device (see col.2 line 62 through col.3 line 49, hyperlink is inherent executable code in an XML element).

Mankoff fails to disclose means for conveying said transmitted signal from said transmitter to the handheld device located within said context.

In the same field of advertisement provider, Treyz et al. disclose means for conveying said transmitted signal from said transmitter to the handheld device located within said context (see col.55 lines 30-34) if user has previously expressed an interest in the service. Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mankoff with the above teaching of Treyz et al. in order to provide the receiver receiving coupons when it is detected in range of retail store.

Mankoff fails to disclose information formatted by the transmitter.

In the related art, Sharma discloses information formatted by the transmitter (see col.4 lines 55-66). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mankoff with the above teaching of Sharma in order to provide a XML standard grammar that is well understood by other devices.

Regarding claim 35, the modified Mankoff discloses displaying the information to the user only if the user has established a preference prior to receiving the signal (Mankoff does not mention if user previously interested receiving information; therefor, Mankoff displays information only the device being manually operated).

Regarding claim 39, the modified Mankoff discloses using the coverage area to define a context for the user receiving the emitted signal (see col.55 lines 30-34).

Regarding claim 40, the modified Mankoff discloses the step of encapsulating the XML element in an integrity XML element (see Mankoff, col.5 lines 25-45).

Regarding claim 42, Mankoff fail to disclose determining if said formatted contextually-relevant information is preferred by the user.

Treyz et al. disclose determining if said formatted contextually-relevant information is preferred by the user (see col.55 lines 30-34). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mankoff with the above teaching of Treyz et al. in order to provide advertisement information based on user profile.

Regarding claims 30, 43 and 46-47, the modified Mankoff fail to disclose at least one broadcast signal; means for transmitting by the transmitter said at least one broadcast signal (see Sharma, fig.1 element 110).

Allowable Subject Matter

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding dependent claim 18, the prior arts fail to disclose "said integrity further element includes: a checksum value, said checksum value representative of said information; a

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size value, said size value indicating the size of said information; a seed value, said seed value being used in computing said checksum value; and an operator, said operator being used in conjunction with said size value and said seed value to compute said checksum value", as cited in the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed Tu Nguyen whose telephone number is 571-272-7883.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



September 19, 2006